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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,452

11/20/2003

Ulrich Sander

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HODGSON RUSS LLP

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SUITE 2000

BUFFALO, NY 14203-2391

EXAMINER

AMARI, ALESSANDRO V

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,452

Applicant(s)

SANDER, ULRICH

Examiner

Alessandro V. Amari

Art Unit

2872

Pw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4, 5, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura US2001/0010592.

In regard to claim 1, Nakamura discloses (see Figures 1-3) a stereomicroscope comprising an objective (21) having an optical axis extending substantially vertically, a zoom system (22) downstream of the objective, and a deflector element (P1) between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 2, Nakamura discloses (see Figures 1-3) that the zoom system has four magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 4, Nakamura discloses (see Figures 1-3) that the zoom system has four magnification or observation channels (corresponding to 5, 8, 9, 11, 12) and two of the magnification or observation channels of the zoom system extend horizontally

at the same height (see 8, 9) and two of the magnification channels of the zoom system extend horizontally at a vertical spacing from one another (see 5, 11).

Regarding claim 5, Nakamura further discloses (see Figures 1-3) another deflector element (P2) downstream of the zoom system for deflecting fewer than all of the observation beams.

In regard to claim 8, Nakamura discloses (see Figures 1-3) a stereomicroscope comprising an objective (21) having an optical axis extending substantially vertically, a zoom system (22) downstream of the objective, and a deflector element (P1) between the objective and the zoom system for deflecting observation beams emerging from the objective into corresponding magnification or observation channels of the zoom system; deflector elements (B2, P2) downstream of the zoom system for redirecting observation beams along a horizontal direction that is substantially opposite to a horizontal direction along which the observation beams travel through the zoom system, wherein the zoom system includes at least three substantially horizontally extending magnification or observation channels (corresponding to 5, 8, 9, 11, 12).

Regarding claim 9, Nakamura further discloses (see Figures 1, 2) at least one optical add-on component (8, 9, 12) having a horizontally or vertically extending optical axis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Kleinberg US 5,052,789.

In regard to claims 6 and 7, Nakamura teaches the invention as set forth above but in regard to claims 6 and 7, does not teach that the stereomicroscope further comprises a deflector element which is pivotable about a horizontal or vertical axis.

Regarding claims 6 and 7, Kleinberg does teach (see Figures 2, 10) a deflector element (36, 38, 48, 50, 60, 62) which is pivotable about a horizontal or vertical axis as described in column 3, lines 49-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to pivot the deflector element as taught by Kleinberg in the stereomicroscope of Nakamura in order to allow for angular deviation of the microscope system while maintaining correct image orientation.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Straehle et al US 20030165012.

Regarding claim 10, Nakamura teaches the invention as set forth above but does not teach an SDI element.

Regarding claim 10, Straehle et al does teach (see Figure 7) an SDI device (750) as described in page 6, paragraph 0063.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the SDI as taught by Straehle et al in the

stereomicroscope of Nakamura in order to provide reversion of the optical image for ease of viewing of the object.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Simon et al US 6,356,088.

Regarding claim 11, Nakamura teaches the invention as set forth above but does not teach a laser shutter.

Regarding claim 11, Simon et al teaches a laser shutter as described in column 2, lines 15-33.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a laser shutter as taught by Simon et al in the stereomicroscope of Nakamura in order to ensure laser safety in the device.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Takahama et al US 5,861,982.

Regarding claim 12, Nakamura teaches the invention as set forth above but does not teach that the add-on component includes an optical splitter.

Regarding claim 12, Takahama et al teaches the at least one opto-mechanical component includes a beam splitter as described in column 10, lines 49-53.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the opto-mechanical components as taught by Takahama et al in the stereomicroscope of Nakamura in order to accurately insert/remove optical components into/from corresponding switching positions without a complicated adjustment as described in column 6, lines 13-18 of Takahama et al.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592 in view of Shioda et al US 6,081,371.

Regarding claim 13, Nakamura teaches the invention as set forth above but does not teach a data projecting device.

Regarding claim 13, Shioda et al does teach (see Figures 18, 19) a data projector (126, 127, 129, 130, 131, 132).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the data projector of Shioda et al in the stereomicroscope of Nakamura in order to observe other data about the specimen in the same visual field as the observed image of the specimen.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura US 2001/0010592.

Regarding claim 14, Nakamura teaches the invention as set forth above but does not teach a filter. Official Notice is taken that it is notoriously old and well known in the microscope art to have additional components such as filters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add filters to the stereomicroscope of Nakamura as claimed above in order to provide improved viewing of the specimen under examination.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 2, and 4-14 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava/vh
10 January 2006

Alessandro Amari

Alessandro Amari

Examiner AU2872